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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/175,905	10/20/1998	DENNIS W. HICKS	0142-0317P	7486
2292	7590	02/07/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			BASHORE, WILLIAM L	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/175,905	HICKS ET AL.	
	Examiner	Art Unit	
	William L. Bashore	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-72, 74-216 and 218-290 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-72, 74-216 and 218-290 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This action is responsive to communications: RCE and amendment, both filed 11/18/2004, to the original application filed 10/20/1998, with provisional filing date of 10/22/1997.
2. The rejection of claims 1-288 under 35 U.S.C. 103(a) as being unpatentable over Suzuki, Goertz, Guck, and Shimizu has been withdrawn as necessitated by amendment.
3. Claims 1-72, 74-216, 218-290 pending. Claims 73, 217 have been canceled. Claims 289, 290 have been added. Claims 1, 145 are independent claims.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/18/2004 has been entered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-72, 74-216, 218-290 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guck, U.S. Patent No. 5,911,776 issued June 1999, in view of Shaw et al. (hereinafter Shaw), U.S. Patent No. 5,881,213 issued March 1999, and further in view of Suzuki et al. (hereinafter Suzuki), U.S. Patent No. 6,213,652 issued April 2001, and further in view of Goertz et al. (hereinafter Goertz), U.S. Patent No. 6,173,295 issued January 2001.

In regard to independent claim 1, Guck teaches automatic format conversion of a document into a specific device compatible document via streaming (from one computer to another), and a shadow file on a central computer dedicated to a particular output format. (Guck Abstract, column 4 lines 40-55, column 5 lines 19-24, column 8 lines 55-67; compare with claim 1 “*a system for delivering documents across a network... which system comprises:*”).

Guck does not specifically teach “an integrated solution”. However, Suzuki teaches a job scheduling device which centralizes all aspects of document translation, etc. into a print job, which is a form of integrated solution (Suzuki Abstract; compare with claim 1 “*...an integrated solution...*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of centralized integrated “jobs” for complete processing.

Guck does not specifically teach document translation of an input stream into a stream having an output device independent format at client side. However, Shaw teaches print jobs (typically originating from an inputted authored document via an editor) spooled in a device-independent format (enhanced metafile format) at a workstation, to eventually be sent (i.e. a data stream) over a network to a network print server to be printed on different printers accordingly (Shaw Abstract, Figure 1A, 8, column 1 lines 41-56; compare with claim 1 “*a document generator at a client's side... independent format data stream*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to allow Shaw to output its device independent stream to Guck's server, providing Guck the benefit of a device independent “standard base” format for translating into device specific formats (i.e. a FAX printer – Guck Figure 1).

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Guck teaches translation of a received authored base document file into specific formats (using shadow files) so as to be tailored and transmitted to specific devices, accordingly (i.e. FAX printers, etc.) (Guck Abstract, column 4 lines 40-55, column 5 lines 19-24, column 8 lines 55-67, Figure 1A; compare with claim 1 *“a computer configured to receive the device independent format data stream... output devices available to the computer”*, and *“the computer further being programmed to translate... output device.”*).

Guck does not specifically teach selecting a “best output device” according to compatible features, etc. However, Goertz teaches a print server whereby a decision is made by said server regarding selection of an appropriate printer able (i.e. best able) to handle a job request (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claim 1 *“... best output device... ”*). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Guck, providing Guck a way to incorporate optimum selections of diverse printer types to accommodate specialized document requirements if/when necessary.

In regard to dependent claim 2, Guck does not specifically teach a job ticket etc. However, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes, including document data (Suzuki column 45 lines 5-27). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of centralized integrated “jobs” for complete processing.

In regard to dependent claims 3-4, Guck does not specifically teach an “affinity value” for calculating a best output device. However, Goertz teaches appropriate selection from a set of diverse printers in order to process a print job, which is a form of comparison/decision making, and which incorporates basic numerical comparison at a coding algorithm level (algorithmic coding decisions are quantified at some level – i.e. Boolean TRUE/FALSE, etc.). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Guck, providing Guck the advantage of choosing the best printer to handle a special job. (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 3-4).

In regard to dependent claims 5-8, Guck does not specifically teach assigning a job to each printer. However, Suzuki teaches a printer job assigned to each printer (Suzuki column 48 lines 60-67; compare with claims 5-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of multiple jobs for diverse printers.

In regard to dependent claims 9-12, Guck does not specifically teach an “affinity value” for calculating a best output device. However, Goertz teaches appropriate selection from a set of diverse printers in order to process a print job, which is a form of comparison/decision making, and which incorporates basic numerical comparison at a coding algorithm level (algorithmic coding decisions are quantified – i.e. Boolean TRUE/FALSE, etc.). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Goertz to Guck, providing Guck the advantage of choosing the best printer to handle a special job. (Goertz column 4 lines 35-40, 48-51, Figure 1 items 20, 28, 30, 31, 32; compare with claims 9-12).

In regard to dependent claims 13-24, Guck does not specifically teach assigning a job to each printer in a network. However, Suzuki teaches a printer job assigned to each printer in a multiple printer network (Suzuki column 48 lines 60-67; compare with claims 13-24). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of multiple jobs for diverse printers.

In regard to dependent claims 25-36, Guck does not specifically teach various elements, etc.. However, Suzuki teaches a job ticket comprising various elements (i.e. printer name, output-bin-name) to be transmitted to a printer (Suzuki column 45 lines 5-27; compare with claims 25-36). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of jobs with specific customized instructions for diverse printers.

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In regard to dependent claims 37-72, Guck does not specifically teach a separate device, etc.. However, Suzuki teaches a separate system comprising a print processor, a job accepting means, a queuing means, an output means, a converting means, and a conversion control means (Suzuki column 10 lines 19-37; compare with claims 25-72). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of jobs with separate and specific areas for diverse printers.

In regard to dependent claims 74-144, Guck does not specifically teach embedding data etc.. However, Suzuki teaches a job scheduling ticket comprising a job name, a client name (user-name), and various document attributes (Suzuki column 45 lines 5-27; compare with claims 73-144). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Suzuki to Guck, providing Guck the benefit of centralized integrated “jobs” for complete processing.

In regard to independent claim 145, claim 145 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Guck does not specifically teach a client side document generator configured to selectively translate and output an output device independent format. However, Shaw teaches providing an option to a user asking if said user wants jobs printed, etc. (Shaw Figure 7 item 75), therefore teaching a user (selectively) initiating print jobs (using Shaw’s system of translating and outputting accordingly) (compare with claim 145 “... *to selectively translate*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Shaw to Guck, providing Guck the benefit of user selection, so as giving a user the advantage of selective printing.

In regard to dependent claims 146-216, 218-288, claims 146-216, 218-288 incorporate substantially similar subject matter as claimed in claims 2-72, 74-144, respectively, and are rejected along the same rationale.

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In regard to dependent claims 289, 290, Guck teaches a computer at a server site (Guck Figure 1 item 50).

Response to Arguments

7. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

In addition, Applicant argues that the cited references do not teach a best device based upon affinity value analysis. It is noted that Goertz teaches a print server whereby a decision is made by said server regarding selection of an appropriate printer able (i.e. best able) to handle a job request. Goertz also teaches appropriate selection from a set of diverse printers in order to process a print job, which is a form of comparison/decision making, and which incorporates basic numerical comparison at a coding algorithm level (algorithmic coding decisions are quantified at some level – i.e. Boolean TRUE/FALSE, etc.).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Bashore

WILLIAM L. BASHORE
PATENT EXAMINER
TECH CENTER 2100

February 02, 2005